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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/824,118
Inventor(s) : Haimanot Bekele, *et al.*
Filed : April 14, 2004
Art Unit : 1615
Examiner : Tristan J. Mahyera
Docket No. : 9209M
Confirmation No. : 6444
Customer No. : 27752
Title : Anhydrous, Transfer-Resistant Cosmetic Lip Compositions

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Office Action of August 7, 2007, a one month extension of time is required to respond to this action and is requested on a separate paper filed hereon, applicants hereby elect the invention represented by the claims of examiner's Group I, namely, claims 1-17 and 22-24, with traverse, for examination on the merits at this time. It is submitted, however, that all claims 1-24, i.e., examiner's Groups I and II, should be examined at this time. The novelty of the invention is defined in the claims of both Group I and Group II, which are not two independent and distinct inventions because the statutory requirements of 35 U.S.C. §121, namely, independence and distinctness, are not present herein.

The inventions of examiner's Groups I and II are not independent because the compositions and the methods set forth in the claims are so closely related that a search for applicants' elected composition and kit claims of examiner's Group I would necessarily encompass a search for the method claims of examiner's Group II.

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In addition, even if the inventions are considered independent, there is no evidence that a search directed to both the compound/kit claims and to the method claims would be a *serious burden* on the examiner, as is required by M.P.E.P. §803. ("If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." and "There must be a serious burden on the examiner if restriction is not required."). This is especially applicable in the instant application wherein *all* claims are classified in class 424, subclass 64.

In particular, is submitted that a complete search directed to the subject matter of the composition and kit claims of examiner's Group I would require a search directed to the subject matter of the method claims of examiner's group II, and vice versa.

Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute (a) the composition and kit claims and (b) method claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office to prosecute the composition/kit and method claims in separate applications. Search and examination of both groups of claims in a single application would be much more efficient than requiring the Patent Office and applicants to do so in separate applications. Accordingly, it is submitted that all claims 1-24 should be examined at this time.

The Office Action also requires election of species. In particular, because applicants have provisionally elected Group I for examination, applicants are required to elect from various disclosed species of compounds recited in the claims. Applicants respectfully traverse the election of species because there is no serious burden placed on the examiner to consider all species.

Under MPEP §806.01, a provisional election of a single species may be required where only generic claims are presented and the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary.

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Applicants respectfully assert that there is no undue burden placed on the Patent Office in examining all species.

With respect to the modified silicones, the claimed list of modified silicones contains only aminosilicones, carboxy modified silicones, and epoxy modified silicones. Thus, searching for one of these modified silicones also will encompass the two other modified silicones. Applicants respectfully assert that while the chemical structure of modified silicones may differ slightly in functional groups, they all are functionalized silicones that are commonly classed together for searching purposes. Thus, applicants respectfully assert that there is no undue burden placed on the Patent Office in examining all claimed modified silicones.

With respect to the organosiloxane resin, this claimed ingredient encompasses a wide and well-known class of silicone resins. Applicants respectfully assert that the structure of the organosiloxane resins are sufficiently similar that they are classed together for searching purposes. Thus, applicants respectfully assert that there is no undue burden placed on the Patent Office in examining the claimed organosiloxane resin.

With respect to the diorganosiloxane polymer, these polymers are *all* of the same type, as demonstrated in the structure at page 5, lines 1-5 of the specification, with the exception of C₁₋₆ groups in place of the Me groups. Applicants respectfully assert that while the chemical structures of the diorganosiloxane polymers differ, the difference is so slight that they are commonly classified together for searching purposes. Thus, applicants respectfully assert that there is no undue burden placed on the Patent Office in examining the claimed diorganosiloxane polymers.

With respect to the volatile carrier, the disclosed carriers include volatile C₃ to C₂₀ hydrocarbon oils and volatile cyclomethicones having a 4, 5, or 6-membered ring. Applicants respectfully submit that while the chemical structure of the volatile hydrocarbons and volatile silicones differ, they are both volatile carriers that are commonly classed together for searching purposes. Thus, applicants respectfully assert that there is no undue burden placed on the Patent Office in examining the claimed volatile carriers.

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With respect to a thickness/structure builder, the compositions preferably contain this ingredient. This claimed element is *not* recited in claim 1, and, accordingly places no burden on the Patent Office in examining independent claim 1.

Furthermore, if applicants are required to chose one modified silicone, one organosiloxane resin, one diorganosiloxane polymer, one volatile carrier, and one thickness/structure builder, then applicants, in effect, would be required to file a multitude of divisional applications directed to each potential combination of claimed ingredients. Because search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute numerous separate divisional applications. Search and examination of all species in a single application would be much more efficient than requiring the Patent Office to prosecute the various species in separate applications. Accordingly, it is submitted that all species should be examined at this time.

For these reasons, applicants submit that the election of species applied to the above-identified application is improper and should be withdrawn.

In the event that the examiner's election of species requirement is made final, applicants hereby provisionally elect the following species, with traverse:

- (a) Modified silicone – aminosilicone (e.g., claim 1);
- (b) Organosiloxane resin – an organosiloxane resin comprising $R_3SiO_{1/2}$ "M" units and SiO_2 "Q" units, wherein the ratio of $R_3SiO_{1/2}$ to SiO_2 is about 0.7 (specification, page 4, lines 10-11);
- (c) Diorganosiloxane polymer – poly(dimethylsiloxane) (e.g., claim 11);
- (d) Volatile carrier – isododecane (e.g., claim 15); and
- (e) Thickness/structure builder – organically modified clay, e.g., organically modified bentonite (claim 4).

Claims readable on these elected species are claims 1-17 and 22-24.

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Reconsideration and withdrawal of the restriction and election of species requirements are respectfully requested. An early action on the merits is solicited.

Applicants reserve the right to pursue the non-elected species in one or more divisional applications.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By



Signature

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